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REMARKS

The Examiner has requested replacement drawing sheets in compliance with 37 CFR 1.121(d). Applicant has submitted herewith such replacement drawing sheets.

The Examiner has objected to the specification because the element numbers of Figure 5 do not correspond to the element numbers as described in the drawings. Applicant has amended the specification to correctly refer to Figure 5.

The Examiner has objected to Claim 2 due to informalities. Applicant has clarified such claim to overcome such objection.

The Examiner has rejected Claims 1-24 under 35 U.S.C. 103(a) as being unpatentable over Cozza (U.S. Patent No. 5,502,815) in view of Waldin et al. (U.S. Patent No. 6,094,731). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove to each of the independent claims.

With respect to each of the independent claims, the Examiner has relied on the following excerpt from Cozza to make a prior art showing of applicant's claimed "storing data identifying computer files that have been written to a data storage device and for which a scan for malware has yet to be performed."

"Referring to FIG. 2, the apparatus for detecting computer viruses of the present invention includes a central processing unit 16. Information concerning the current state of volumes 17 or files 18 is stored in RAM 19, and information concerning prior states is stored in the scan information cache(s) 20." (Cozza-Col. 3, lines 35-40)

Applicant respectfully asserts that such excerpt relates to storing information on states of files such that changes in a file size of the stored information may be utilized for determining a subset of viruses to scan for (see Abstract). Clearly, such excerpt does not even suggest applicant's claim language where "data [is stored that] identify[ies]

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computer files that have been written to a data storage device and for which a scan for malware has yet to be performed" (emphasis added).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above. Nevertheless, despite such paramount deficiencies and in the spirit of expediting the prosecution of the present application, applicant has included the following claim language in each of the independent claims:

"scanning code operable as a low priority task within a multitasking environment to conduct malware scanning upon computer files identified within said pending scan database as haven been written to the data storage device and for which the scan for malware has yet to be performed" (see the same or similar, but not identical language in each of the independent claims).

For substantially the same reasons as argued above, applicant respectfully asserts that neither Cozza nor Waldin teach "scanning code operable as a low priority task within a multitasking environment to conduct malware scanning upon computer files identified ... as haven been written to the data storage device and for which the scan for malware has yet to be performed," as presently claimed by applicant.

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Applicant further notes that the prior art is also deficient with respect to the dependent claims. Just by way of example, with respect to Claim 2 et al., the Examiner has relied on Col. 2, line 55-Col. 3, line 8 from Cozza to make a prior art showing of applicant's claimed "file write code operable as a computer file is written to a storage device to add data identifying said computer file to said pending scan database."

Applicant respectfully asserts that such excerpt only teaches that "information detailing the initial 'state' of an uninfected file...can be 'cached'." However, Cozza does not teach when such state information is stored, but only that the file must be in an initial state. Clearly, only generally teaching storing initial state information of a file, as in Cozza, does not meet applicant's specific claim language, namely that "as a computer file is written to a storage device...data identifying said computer file [is added] to said pending scan database" (emphasis added). Furthermore, Cozza only teaches that the state information is stored, but not that it is stored to a "pending scan database," as claimed by applicant. In fact, Cozza only scans a current state data, which would not require the initial state information to be stored in a pending scan database.

With respect to Claim 4 et al., the Examiner has relied on Col. 3, lines 35-40 in Cozza to make a prior art showing of applicant's claimed "scanned file database code operable to maintain a scanned file database storing data identifying computer files that have been scanned for malware." Applicant respectfully asserts that such excerpt only teaches storing information on a current state and prior states of a file. When read in context, Cozza stores such states for determining what set of viruses to scan the associated file for (see Abstract). Thus, Cozza does not teach a "scanned file database...[for] storing data identifying computer files that have been scanned for malware" (emphasis added).

With respect to Claim 7 et al., the Examiner has relied on Col. 3, lines 35-55 in Cozza to make a prior art showing of applicant's claimed "initiation code operable upon startup to detect any computer files stored on a storage device not included within either

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said pending scan database or said scanned file database and to add such computer files to said pending scan database.”

Applicant respectfully asserts that Cozza only teaches storing states of files and using such states to scan each file “stored in a memory system.” However, Cozza does not specifically teach a “pending scan database” and “scanned file database”, let alone detecting “upon startup... any computer files stored on a storage device not included within either said pending scan database or said scanned file database and...add[ing] such computer files to said pending scan database.” as claimed by applicant (emphasis added).

Since at least the third element of the *prima facie* case of obviousness has not been met, as noted above, a notice of allowance or a proper prior art showing of all of the claim limitations, in the context of the remaining elements, is respectfully requested.

Still yet, applicant brings to the Examiner’s attention the subject matter of new Claims 25-27 below, which are added for full consideration:

“wherein an order of said computer files identified within said pending scan database being scanned is based on an algorithm that estimates the likelihood of a read request being performed on each computer file” (see Claim 25);

“wherein only computer files determined to be clean from the malware scanning are stored in the scanned file database” (see Claim 27); and

“wherein an order of said computer files identified within said pending scan database being scanned is based on the order in which said computer files were placed in said pending scan database” (see Claim 28).

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

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In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NAI1P486/01.060.01).

Respectfully submitted,  
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